

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

TRADEMARK TRIAL AND
APPEAL BOARD

Express Mail Label: EV 107 635 669 US

Mailing Date: August 12, 2002

02 AUG 21 AM 12:05

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

*Miscellaneous
Exparts*

Applicant: Marshall Cavendish
Corporation

Mark: WE CAN READ ABOUT NATURE!

ON APPEAL

Serial No: 76/090,373

Filed: July 17, 2000

Law Office: 110

Examining Trademark

Attorney: William P. Jacobi

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57
08-12-2002

TO: Trademark Trial and Appeal Board
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

APPLICANT'S REPLY BRIEF ON APPEAL
UNDER 37 C.F.R. § 2.142(b)(1)

Leo Zucker
Attorney For Applicant
50 Main Street, Suite 480
White Plains, NY 10606

Telephone: (914) 761-7799

August 12, 2002

INTRODUCTION

Applicant Marshall Cavendish Corporation respectfully submits the present reply brief in response to the Examining Attorney's appeal brief ("Ex. Br.") filed on July 25, 2002.

ARGUMENT

The Mark of the Cited '847 Registration Is Not a "Phantom" Trademark and Should Not Be So Regarded When Assessing Likelihood of Confusion

Applicant seeks to register "WE CAN READ ABOUT NATURE!" for a non-fictional nature book series for young readers. The mark of the '847 registration is for "I CAN READ ABOUT" for a series of children's books. The registered mark is *not* "I CAN READ ABOUT ----", where "----" denotes an unlimited number of subjects or topics, including nature. In fact, an application to register such a "phantom" trademark would be rejected by the PTO as a violation of its one mark per registration policy. *In re International Flavors and Fragrances*, 183 F.3d 1361, 51 U.S.P.Q.2d 1513 (Fed. Cir. 1999) at 1518; and *Cineplex Odeon v. Fred Wehrenberg Circuit of Theatres*, 56 U.S.P.Q.2d 1538 (T.T.A.B. 2000). See generally, R. Callmann, *Unfair Competition, Trademarks & Monopolies* (4th ed.), Spring 2002 Cumulative Supp., § 25.35 at 160-63; and J. McCarthy, *Trademarks & Unfair Competition*, § 19:61.1 at pages 19-149 to 151

(Rel. 22, 06/2002). Accordingly, a word that is not part of the registered mark should not be added to it prior to comparing the registered mark and applicant's mark under § 2(d) of the Trademark Act. The registrant chose not to register "I CAN READ ABOUT NATURE", or any of the various book titles (none of which includes the word "nature") to which the Examining Attorney refers (Ex. Br., 7). To imply that consumers would "expect" a specific subject matter to follow the registered mark (Ex. Br., 6-7), effectively accords the registered mark the status of a phantom trademark and thus enlarges the scope of protection to which the mark should be entitled.

The Marks at Issue Differ Sufficiently to Enable Reasonable Purchasers to Distinguish the Sources of Applicant's and Registrant's Goods from One Another

The Examining Attorney alleges that "the mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under § 2(d)", citing *Coca-Cola Bottling Co. v Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 U.S.P.Q. 105 (C.C.P.A. 1975). Ex. Br., at page 6. But the cited case makes no such conclusion. According to the decision,

"When one incorporates the entire *arbitrary* registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion." *Id.*, 188 U.S.P.Q. at 106. (emphasis added)

First, applicant has not incorporated the “entire” registered mark into its present mark, and, second, the registered mark is not one that could reasonably be considered as “arbitrary” with respect to the registrant’s goods. More to the point is, *e.g.*, *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986)(BED & BREAKFAST REGISTRY and BREAD & BREAKFAST INTERNATIONAL, both for reservation services, held not confusingly similar).

Applicant acknowledges that the marks at issue do share the words “CAN READ ABOUT”, but submits that such words alone are not highly distinctive in relation to registrant’s goods notwithstanding the Examining Attorney’s assertions to the contrary. See Ex. Br. at pages 4-5. Assuming *arguendo* that registrant owns the only mark on the Principal Register containing the three words “can read about”, that fact alone does not render the words arbitrary with respect to a series of children’s books. And,

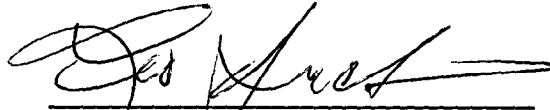
“[i]f the common element of two marks is ‘weak’ in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality.”
T.M.E.P. § 1207.01 (b) (viii) (Jan. 2002)

The marks at issue have no other commonality.

CONCLUSION

In view of all the foregoing, the refusal of the Examining Trademark Attorney to register WE CAN READ ABOUT NATURE! under Section 2(d) of the Trademark Act, should be reversed.

Respectfully submitted,


Leo Zucker, Attorney for Applicant
Marshall Cavendish Corporation

50 Main Street, Suite 480
White Plains, NY 10606

Telephone: (914) 761-7799

August 12, 2002